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| 10/658,518 | 09/09/2003 | Gail S. Lebovic | CIAN-0101 | 1942 |
| 23410 | 7590 | 01/23/2009 | EXAMINER | |
| Vista IP Law Group LLP | | | GILBERT, SAMUEL G | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|---------------------------------------|
| Office Action Summary | Application No. 10/658,518 | Applicant(s) LEBOVIC ET AL. |
| | Examiner Samuel G. Gilbert | Art Unit 3735 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 June 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 187,189,196 and 198 is/are withdrawn from consideration.
- 5) Claim(s) 191-195,197 and 199-202 is/are allowed.
- 6) Claim(s) 92,95-99,101,105-110,113,114,149,150,152,154-158, 181-186, 188, 190 and 203 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (Form PTO-412)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (Form PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 92,95-99,101,105-110,113,114,149,150,152,154-158,181-186-198 and 199-203.

DETAILED ACTION

Claim Objections

Claim 192 is objected to because of the following informalities:

Claim 192 - in line 1, "wherein the wherein the" appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 200 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 200 - the claim recites the tubular member is a plastic "co-extrusion" however the structure of the co-extrusion is not set forth, further, it is unclear what elements would form the co-extrusion. As set forth the tubular member is a single element and therefore it is unclear how it can be a co-extrusion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 92, 95, 97-99, 101, 107, 108, 113, 114, 149-152 and 155-158 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonan et al (7,182,725, hereinafter Bonan).

Claim 92 - element -98- is an elongate tube, elements -102- and -100- show lumens extending between a proximal and distal opening as shown in figure -14-, a plurality of seeds -42- and -43- and wires -104- and -108- teach a support member shaped to curve the deployment section in the body and insert the tube in a straight configuration.

Claim 95 - the support member is enclosed within tubular member -106- and -112-.

Claim 97 - as shown at -104- the support member has a curvature in a relaxed state.

Claim 98 - the support member is sufficiently flexible to permit a curved implantation.

Claim 99 - lumen -100- is a first lumen and lumen -106- is a second lumen.

Claim 101 - elements -42- and -43- are spaced apart along the tubular member.3

Claim 107 - element -98- is an elongate tube, elements -102- and -100- show lumens (lumen -100- is a first lumen) extending between a proximal and distal opening as shown in figure -14-, a plurality of seeds -42- and -43- and wires -104- and -108- teach a support members (outside the first lumen) shaped to curve the deployment section in the body and insert the tube in a straight configuration. The support member is fixed inside the lumens --106- and -112- along the therapy delivery portion. The tail portion extends outside the body to allow delivery of the seeds.

Claim 108 - the therapy portion may be curved as shown in figures 13a and 13b.

Claim 113 - a plurality of seeds are introduceable into the lumen.

Claim 114 - the seeds are spaced apart along the catheter.

Claim 149 - element -98- is an elongate tube, elements -102- and -100- show lumens (lumen -100- is a first lumen) extending between a proximal and distal opening as shown in figure -14-, a plurality of seeds -42- and -43- and wires -104- and -108- teach a support members (outside the first lumen) shaped to curve the deployment section in the body and insert the tube in a straight configuration. The support member is fixed inside the lumens --106- and -112- along the therapy delivery portion and offset from the source lumen. The tail portion extends outside the body to allow delivery of the seeds.

Claim 150 - the therapy portion may be curved as shown in figures 13a and 13b.

Claim 152 - the control elements are wire elements which are considered a metallic strip.

Claim 154 - the support member is encased within lumens -106- and -112-.

Claim 155 - lumen -100- is a first lumen and lumen -106- is a second lumen.

Claim 157 - the curved portion includes seeds in a repeating pattern around the curve.

Claim 158 - the device is capable of curving within the target tissue region.

Claim 181 - element -98- is an elongate tube, elements -102- and -100- show lumens (lumen -100- is a first lumen) extending between a proximal and distal opening as shown in figure -14-, a plurality of seeds -42- and -43- and wires -104- and -108- teach a support members (outside the first lumen) shaped to curve the deployment section in the body and insert the tube in a straight configuration. The support member is fixed inside the lumens --106- and -112- along the therapy delivery portion and offset from the source lumen. The tail portion extends outside the body to allow delivery of the seeds. The support members are offset asymmetrically relative to the first lumen

Claim 183 - the support member is enclosed within lumens -106- and -112-.

Claim 184 - lumen -100- is a first lumen and lumen -106- is a second lumen and the support members are substantially fixed in the lumens.

Claim 185 - the wire is considered a strip of material.

Claim 186 - the wire will inherently attenuate radiation passing through it.

Claim 203 - element -98- is an elongate tube, elements -102- and -100- show lumens (lumen -100- is a first lumen) extending between a proximal and distal opening as shown in figure -14-, a plurality of seeds -42- and -43- and wires -104- and -108- teach a support members (outside the first lumen) shaped to curve the deployment

section in the body and insert the tube in a straight configuration. The support member is fixed inside the lumens --106- and -112- along the therapy delivery portion and offset from the source lumen. The tail portion extends outside the body to allow delivery of the seeds. The support members are offset asymmetrically relative to the first lumen

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 105, 106, 109, 110, 188 and 190 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonan et al (7,182,725, hereinafter Bonan).

Bonan teaches a device as claimed but only sets forth a single device. The duplication of elements of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Making and using a plurality of devices would have been obvious to one of ordinary skill in the medical arts at the time the invention was made.

Claim 188 - Bonan teaches a plurality of seeds but not a cable. It is old and well known in the medical arts to use source wires(cables) in place of individual seeds to speed the delivery of the devices to protect the patient and doctor from unintended exposure to radiation. It would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to use a source wire in place of the individual

seeds and pressure source to deliver the seeds to the treatment location. The substitution would produce a predictable result with a high expectancy of success.

Claims 92, 96, 149, 156, 181 and 182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonan et al (7,182,725, hereinafter Bonan).

The applicant's attention to the embodiment of figures 10a through 10c and elements -78- are heat shrink tubes, elements -76- and -79- are support members asymmetrically offset to the first lumen -74- extending between a proximal and distal opening.

Allowable Subject Matter

Claims 191-195, 197 and 199-202 is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel G. Gilbert/
Primary Examiner, Art Unit 3735

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